



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,724	04/17/2001	Guenter Lukas	112740-189	8116

29177 7590 05/08/2003

BELL, BOYD & LLOYD, LLC  
P. O. BOX 1135  
CHICAGO, IL 60690-1135

EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 05/08/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/836,724

Applicant(s)

LUKAS, GUENTER

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “exchanging digital communication data from.....switching system” is not clearly defined. It is unclear the communication data is exchanged from the communication connection to where.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

Art Unit: 2645

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 3, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (US: 6529602).

For claims 1 and 6, regarding “connecting.....connection”, Walker et al teach on Fig. 1A and item 26a Fig. 2 connection between first user and second user, and digital switching system.

Regarding “exchanging.....switching system”, Walker et al teach on item 12 Fig. 1A digital recording system. Walker et al teach on item 26a PBX (claimed “digital switching system”). Walker et al also teach on column 5 line 23-25 recording conversation between multiple parties to the audio vault. It is obvious the digital communication data is exchanged from the communication connection to the recording system.

Regarding claim 2, Walker et al teach on Fig. 1D and 1E recording and reproducing audio information. The communication connections for recording and reproducing audio information are pre-defined by the calling station and the called station.

Regarding claim 3, Walker et al teach on column 6 line 35 audio vault places a call (via the switch, item 26a Fig. 2) to party B. It is obvious the call made by the switch is controlled by the vault (claimed “recording system”).

Art Unit: 2645

Regarding claim 5, Walker et al teach on column 10 line 26-28 digital content of the conversation (reads on the claimed “digitized voice”).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al as applied to claim 3 above, and in view of Garcia (US: 6442247). Walker et al failed to teach “establishing.....CTI connection”. However, Garcia teaches on column 3 line 65 to column 4 line 10 a CTI processor (claimed “CTI connection”) connects a telephone switch and a data repository (claimed “recording system”) for accessing recorded messages to be played. The CTI must exchange (call) control information between the switch and the recording system for routing the call and retrieving messages. It would have been obvious to one skilled at the time the invention was made to modify Walker et al to have the “establishing.....CTI connection” as taught by Garcia such that the modified system of Walker et al would be able to support the CTI to the system users.

Art Unit: 2645

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al as applied to claim 6 above, and in view of Weishut et al (US: 6047057). Walker et al failed to teach “the digital data connection includes an  $S_0$ ”. However, Weishut et al teach on Fig. 1 connecting two end stations by an  $S_0$  interface. It would have been obvious to one skilled at the time the invention was made to modify Walker et al to have the “the digital data connection includes an  $S_0$ ” as taught by Weishut et al such that the modified system of Walker et al would be able to support the  $S_0$  to the system users.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al as applied to claim 6 above, and in view of Waugh et al (US: 6324402).

Regarding claim 10, Walker et al failed to teach “the digital recording system is a personal computer”. However, Waugh et al teach on column 5 line 39-42 a personal computer configured to receive and store voice messages. It would have been obvious to one skilled at the time the invention was made to modify Walker et al to have the “the digital recording system is a personal computer” as taught by Waugh et al such that the modified system of Walker et al would be able to support the personal computer to the system users.

Regarding claim 11, the modified system of Walker in view of Waugh et al as stated in claim 10 above failed to teach “the personal computer.....the data network”. However, “Official Notice” is taken that a personal computer must be connected to a data network for data transmission is both old and well known in the art. Also, Walker et al teach on column 4 line 65 to column 5 line 4 the first user and the second user can be connected via computer network or

Art Unit: 2645

Internet (both are claimed "data network") for recording and reproducing digital communication data. It would have been obvious to one skilled at the time the invention was made to modify Walker et al and Waugh et al to have "the personal computer.....the data network" as taught by Waugh et al such that the modified system of Walker et al and Waugh et al would be able to support the data network to the system users.

### *Conclusion*

6. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Carter et al (US: 5982858) teach system for providing automatic voice messaging in a digital network environment.

7. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Application/Control Number: 09/836,724

Page 7

Art Unit: 2645

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to TC2600's Customer Service FAX Number 703-872-9314.**

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

